

REMARKS

Reconsideration and allowance of the above-identified application are respectfully requested. Upon entry of this amendment, claims 1, 50, 52-57, 59-61, 63, 64, 66, 67, 69, 72, 73, 75-77, 93, 97, 99, 101-145, 147 and 148 will be pending, wherein it is proposed to amend claims 1, 125, 126 and 142, and cancel claim 146. Entry of the amendment is appropriate after a final rejection because these amendments reduce issues for appeal by overcoming the rejections under 35 U.S.C. §§ 101 and 112.

Claims 59-61, 63, 64, 66, 67, 69, 72, 73, 75-77, 97, 101, 102, 104-138 and 148 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-46 of co-pending Patent Application No. 09/938,866. This ground of rejection is respectfully traversed.

Applicants note that this is a provisional double patenting rejection, and upon patenting of the claims in the co-pending application, Applicants' will evaluate whether the claims of the co-pending application and the present application are subject to the obviousness-type double patenting rejection.

Claims 125, 126, 142 and 146 are rejected under 35 U.S.C. § 112, second paragraph for indefiniteness. Applicants respectfully submit that the amendments to claims 125, 126 and 142, and the cancellation of claim 146

overcome this ground of rejection. Accordingly, withdrawal of this rejection is respectfully requested.

Claims 1, 50 and 52-57 are rejected under 35 U.S.C. § 101 as being directed to non-statutory subject matter. Although this ground of rejection is respectfully traversed, Applicants have amended claim 1 to address the rejection. Specifically, claim 1 now recites “A system for saving web page data, including a processor and a storage medium storing a computer-executable program, said program comprising codes for causing said processor to perform as”. It is respectfully submitted that this amendment overcomes the rejection under 35 U.S.C. § 101.

Furthermore, as discussed during the interview, claim 1 is drafted in the means-plus-function form, and the specification discloses that these functions are performed by a central processing unit (CPU) 101.¹ As discussed in M.P.E.P. § 2181, “the PTO may not disregard the structure disclosed in the specification corresponding to such language when rendering a patentability determination.” Accordingly, it is only by disregarding the specification that this rejection can stand. Otherwise, when the specification is considered, it is clear that the means recited in claim 1 are not mere nonfunctional descriptive material, but instead includes a processor structure.

¹ Page 9, lines 9-12.

For at least those reasons set forth above, it is respectfully requested that the rejection of claims 1, 50 and 52-57 for being directed to non-statutory subject matter be withdrawn.

Claims 1, 59-61, 63, 64, 66, 67, 69, 93, 97, 99, 101-107, 111-132, 143-147 and 148 are rejected under 35 U.S.C. § 103(a) as being obvious in view of the combination U.S. Patent No. 6,567,800 to Barrera et al. (“Barrera”) and U.S. Patent No. 5,983,827 to Cole et al. (“Cole”). This ground of rejection is respectfully traversed.

Applicants’ claim 1 recites a system that acquires web page data *browsed by a browser client when the browser client newly browses* the web page data. The web page data acquired *by the browser client* is saved in correspondence with the assigned indices in a predefined database. In contrast to Applicants’ claim 1, Barrera and Cole do not disclose or suggest systems that operate using web page data acquired by a browser client.

As previously discussed, Barrera discloses a method of retrieving website content of a user-selected category using an *automatic* technique involving a *spider*. Thus, there is nothing in Barrera that discloses or suggests that the method of Barrera involves acquiring web page data browsed by a browser client, but instead Barrera discloses a method that uses a spider to avoid the use of a browser client.

Cole is directed to a system for identifying *new web pages* of interest. Thus, Cole, like Barrera, does not operate using web page data acquired by *the browser client*. Accordingly, Cole, like Barrera, does not disclose or suggest saving web page data acquired by *the browser client* in correspondence with the assigned indices in a predefined database.

The non-obviousness of claim 1 in view of the combination of Barrera and Cole is particularly evident from the reasoning provided in the Response to Arguments section of the final Office Action. In particular, this section state that

Barrera uses web page data that while collected in a different manner than the claimed invention results in the same data being collected and stored. Spiders work much like a user with a browser except must faster to cover more sites.

This statement appears consistent with the Applicants' arguments during the personal interview conducted with the undersigned on October 23, 2007, that the rejection is premised on making the system of Barrera *less desirable* and *more complicated* by taking an automated activity performed by a spider and making the activity manual by requiring user intervention. Thus, as recognized by the Office Action, this modification to Barrera would make the system of Barrera *slower* and would result in coverage of *fewer sites* than compared to using the spider expressly disclosed by Barrera. It is respectfully submitted that one skilled in the art typically is not motivated to make systems less optimal, as is being proposed by the Office Action. Instead, persons skilled in the art are

typically motivated to make systems more efficient, which would be achieved using the spider of Barrera, and not by the browser of Applicants' claim 1.

Furthermore, the Response to Arguments section states that "Cole adds the browser and recently viewed data elements that are missing from Barrera." This, however, ignores the fact that Cole, like Barrera, is completely silent with respect the use of data acquired by a browser client when the browser client newly browses the web page data in the manner recited in claim 1. Instead, as discussed above, Cole is directed to identifying *new* web pages of interest. By definition, these *new* web pages of interest will not have been browsed by a browser.

Because Barrera and Cole each does not disclose or suggest acquiring data from a browser client when the browser client newly browses web page data, and then saving the data in correspondence with the assigned indices as recited in claim 1, the combination of Barrera and Cole does not render claim 1 obvious.

Independent claims 59, 60, 93, 99, 147 and 148 recite similar elements to those discussed above with regard to claim 1, and are patentably distinguishable over the combination of Barrera and Cole for similar reasons.

Claims 61, 63, 64, 66, 67, 69, 97 101-107, 111-132 and 143-146 are patentably distinguishable over the combination of Barrera and Cole at least by virtue of their dependency.

For at least those reasons set forth above, it is respectfully requested that the rejection of claims 1, 59-61, 63, 64, 66, 67, 69, 93, 97, 99, 101-107, 111-132, 143-147 and 148 as being obvious in view of the combination of Barrera and Cole be withdrawn.

Claims 50, 52-57, 75-77 and 133-142 are rejected under 35 U.S.C. § 103(a) as being obvious in view of the combination of Barrera, Cole and U.S. Patent No. 6,081,829 to Sidana (“Sidana”). Claims 72, 73 and 108-110 are rejected under 35 U.S.C. § 103(a) as being obvious in view of the combination of Barrera, Cole and U.S. Patent No. 5,848,410 to Walls et al. (“Walls”).

Claims 50, 52,-57, 72, 73, 75-77, 108-110 and 133-142 variously depend from independent claims 1, 59, 60 and 93. As discussed above, the combination of Barrera and Cole does not render these independent claims obvious. It is respectfully submitted that Sidana and Walls each do not remedy the above-identified deficiencies of the combination of Barrera and Cole. Accordingly, claims 50, 52,-57, 72, 73, 75-77, 108-110 and 133-142 are patentably distinguishable over the current grounds of rejection at least by virtue of their

Serial No. 09/865,773

Amendment Dated: August 11, 2008

Reply to Office Action: March 17, 2008

Attorney Docket No. 103251.58983US

dependency from claims 1, 59, 60 or 93, and the obviousness rejections of these claims should be withdrawn.

If there are any questions regarding this response or the application in general, a telephone call to the undersigned would be appreciated since this should expedite the prosecution of the application for all concerned.

If necessary to effect a timely response, this paper should be considered as a petition for an Extension of Time sufficient to effect a timely response, and please charge any deficiency in fees or credit any overpayments to Deposit Account No. 05-1323 (Docket # 103251.58983US).

Respectfully submitted,

August 11, 2008


Stephen W. Palan
Registration No. 43,420

CROWELL & MORING, LLP
Intellectual Property Group
P.O. Box 14300
Washington, DC 20044-4300
Telephone No.: (202) 624-2500
Facsimile No.: (202) 628-8844
SWP:crr
10604818